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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KOENIG, ANDREW Y

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/201,484

Applicant(s)

CARPENTER ET AL.

Examiner

Andrew Y Koenig

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed 2 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-7, 12, 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 25 March 1999 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.
2. Non-Patent literature to Michael Jones, titled "The Microsoft Interactive TV system: An Experience Report." Technical Report MSR-TR-97-18, July, 1997, Redmond, Washington was not provided.
3. The information disclosure statements filed 14 November 2000, 12 January 2001, 5 February 2001, 26 February 2001, 5 August 2002 have not been considered because of they are missing from the application file.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,883,661 to Hoarty (Hoarty).

Regarding claim 17, Hoarty teaches a television system implementing information services such as video on demand (col. 4, ll. 29-36) employing a system manager and communications gateway (fig. 8, labels 22, 26) that reads on the claimed proxy. Furthermore, Hoarty teaches assigning interactive channels to the users using the system manager (col. 10, ll. 33-41).

Regarding claim 19, the gateway of Hoarty implements an IP addressing scheme for the server side and IHOP addresses for the client side (col. 14, ll. 49-55), clearly Hoarty demonstrates a system where the server and client protocols are different.

6. Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,378,130 to Adams (Adams).

Regarding claim 17, Adams teaches server network supporting video-on-demand (col. 1, ll. 7-11) with a plurality of channels ( $f_1, f_2, f_3, \dots, f_m$ ) (see figures 5-6) and a connection management agent (col. 9, ll. 24-32), which reads on an intermediary processor. Furthermore, Adams teaches the connection management agent assigning different channels to different subscribers (col. 9-10, ll. 59-6).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,883,661 to Hoarty (Hoarty) in view of U.S. Patent 5,898,387 to Davis et al. (Davis).

9. Regarding claim 1, Hoarty teaches a television system implementing information services such as video on demand (col. 4, ll. 29-36) employing a communications gateway (fig. 8, label 26) that reads on the claimed proxy. The gateway implements an IP addressing scheme for the server side and IHOP addresses for the client side (col. 14, ll. 49-55), clearly Hoarty demonstrates a system where the server and client protocols are different. However, Hoarty is silent on changing the proxy when the server or client changes protocols. Davis teaches a gateway enclosure that permits changing interface cards in the gateway (claimed proxy) when either the server or client changes protocols (col. 1-2, ll. 65-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hoarty by changing the gateway when there is a change in the server or client protocol as taught by Davis in order to enable communication between the server and the client without changing the every server and client.

Regarding claim 2, Hoarty teaches a gateway, which reads on the claimed proxy, but is silent on using the same proxy used in different server/client environments. Davis teaches a gateway that is used in a variety of different environments simultaneously (i.e.

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broadband, LLEO, VHF/Telephony, radio, CEBus, PLC, etc.) (col. 2, ll. 38-45; col. 2, ll. 7-9).

Regarding claim 3, the combined system of Hoarty and Davis clearly improves the system by translating the different protocols to enable both systems to communicate.

Regarding claim 4, Hoarty teaches conversion of IHOP addresses to IP addresses, which do not correspond exactly since there exists a translation to convert the protocols due to dynamically changing channels (col. 13, ll. 6-19).

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,883,661 to Hoarty (Hoarty) in view of U.S. Patent 5,729,280 to Inoue et al. (Inoue).

Regarding claim 18, Hoarty teaches assigning channels to the user (col. 13, ll. 1-19), but is silent on reassigning a user to a different channel in the middle of an on-demand video. Inoue teaches changing to a different channel during an on-demand video (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hoarty by changing to a different channel during an on-demand video as taught by Inoue in order to conserve resources and provide a set of services to more users.

### ***Conclusion***

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Lee teaches a synthesizing a gateway that changes quickly to adapt to changing protocols (col. 1, ll. 26-32) and supports one or more protocols (col. 1, ll. 35-36).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

ayk  
December 15, 2002



**VIVEK SRIVASTAVA**  
**PATENT EXAMINER**

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes **incorporated** therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.